

REMARKS/ARGUMENTS

This amendment is presented to expedite the prosecution of the above-identified application.

The present amendment together with the Amendment of July 13, 2005 are believed to overcome the objections to the claims recited in the Final Office Action.

The rejection of Claim 20 under 35 U.S.C. § 112 (second paragraph) as indefinite is traversed and reconsideration is requested in view of the amendment of July 13, 2005 which addresses the issue raised in the Official Action on page 3.

The claims in the case are 1-8, 10 and 12-22.

The indication by the Examiner that Claims 14 and 20-22 would be allowable if rewritten in independent form is noted with appreciation. In the Interview Summary Form of December 10, 2004, it was indicated that Claim 11 would also be allowable. The features of Claims 9 and 11 have been inserted into Claim 7 by the amendment of July 13, 2005. Therefore, it is believed that Claim 7 has been placed in condition for allowance. Dependent Claims 8, 10, 12-21 are now all dependent on Claim 7 and, accordingly, applicants believe that these claims are now also in condition for allowance.

The rejection of Claims 1 and 3-6 under 35 U.S.C. § 102(b) as anticipated by the European Patent Application No. 0 724 968 is traversed and reconsideration is respectfully requested.

The Final Action refers to the Office Action of December 1, 2004, which summarizes the cited European patent reference as describing a pigment-dye combination ink formed by mixing a pigment ink containing a carbon black dispersion with a water soluble Dye Ink B as shown on pages 7-8 of the EP '968 document. The Final Action states that "furnace black and channel black are all examples of gas black". The IUPAC document has been made of record in the Final Action and is relied on in the Advisory Action of August 4, 2005 to establish that furnace black and channel black are examples of gas black. It is clear that EP '968 does not disclose a gas black and so the issue presented herein is whether gas black is identical with furnace black or

channel black. If these products are not identical then the rejection under 35 U.S.C. §102 must be withdrawn for then the reference does not “describe” the invention within the meaning of 35 U.S.C. §102. Applicants have already made of record a copy of literature from Cabot Corporation which identifies the Mogul L as a furnace black which is the material shown in the EP document on page 7.

The following documents are also of record herein:

Exhibit 1. Publication by Degussa AG (assignee herein) entitled:
What is Carbon Black?

Exhibit 2. Technical Bulletin: *Pigments: Properties of Pigment Blacks and Methods for Their Characterization* (also published by assignee)

Exhibit 1 shows the various methods of producing carbon black and discusses the properties of the products. The table on page 33 compares the several different blacks and clearly shows that the properties of the carbon blacks depend upon the method of manufacture.

Exhibit 2 shows, on page 5, the different processes for making gas black, furnace black and lampblack. Of particular interest is Figure 3 on page 8 showing the extremely narrow primary particle distribution for gas blacks compared to the other two blacks. Gas blacks (of the present invention) also have a high structure; see page 13. Note further the differences in surface chemistry as explained on page 19. Other points of distinction between gas blacks and other forms of carbon black include pH; see Table 7 on page 21 and the elemental analysis of several blacks in Table 9 on page 23.

In view thereof, applicants respectfully submit that persons skilled in the art would know that gas blacks are not identical to furnace blacks or any other carbon blacks described in the cited references. Therefore, EP ‘968 does not describe the claimed invention. Accordingly, the rejection under 35 U.S.C. § 102 should be withdrawn.

The rejection of Claims 2, 7, 8, 10, 12, 13 and 15-19 as allegedly obvious (35 U.S.C. § 103), in view of EP '968, is also traversed and reconsideration is respectfully requested.

With regard to the allegation in the Official Action that a person skilled in the art would be lead to substitute any gas black for the carbon black produced by the furnace process or the channel process, applicants would respectfully disagree and note that there is no teaching or allegation that any other type of carbon black would be suitable. There is no motivation to select a gas black from among the many types of carbon blacks that are available, nor would there be any predictability as to success. The record establishes that not all carbon blacks are the same and further that the industry makes clear distinctions with respect to the variety of carbon blacks.

Therefore, applicants' evidence clearly shows that the various carbon blacks are not interchangeable. The record further shows that one could not predict that replacing one carbon black with another could lend to a successful result.

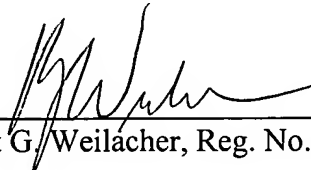
Consequently, applicants respectfully submit that there is lacking a motivation in the '968 European document whereby a person skilled in the art would be lead to substitute a gas black for the furnace black shown in the reference.

For reasons set forth herein, applicants respectfully submit that the rejection fails to establish *prima facie* obviousness and should be withdrawn.

Favorable action at the Examiner's earliest convenience is respectfully requested.

Respectfully submitted,

SMITH, GAMBRELL & RUSSELL, LLP

By: 
Robert G. Weilacher, Reg. No. 20,531

Suite 3100, Promenade II
1230 Peachtree Street, N.E.
Atlanta, Georgia 30309-3592
Telephone: (404): 815-3593
Facsimile: (404): 685-6893